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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/829,631	04/22/2004	Frank J. Hodges	LEXANI.032C2	7298

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EXAMINER
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JOHNSTONE, ADRIENNE C

ART UNIT	PAPER NUMBER
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1733

NOTIFICATION DATE	DELIVERY MODE
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05/03/2007

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com  
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# Office Action Summary

Application No.

10/829,631

Applicant(s)

HODGES ET AL.

Examiner

Adrienne C. Johnstone

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-32 and 35-53 is/are pending in the application.
- 4a) Of the above claim(s) 1-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 31,32,35-42 and 44-53 is/are rejected.
- 7) ☒ Claim(s) 43 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 December 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 4, 2006 has been entered.

### *Election/Restrictions*

2. Claims 1-30 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on September 26, 2005.

### *Drawings*

3. The drawings were received on December 4, 2006. These drawings are acceptable.

### *Specification*

4. The disclosure is objected to because of the following informalities: the drawing numeral 130 added to Figure 10 has not yet been recited in the specification.

Appropriate correction is required.

One way to overcome this objection would be to amend paragraph 50 such that in line 3 after "words" is inserted -- 130 -- .

5. The disclosure is objected to because of the following informalities: applicants should correct the typographical error in paragraph 0001 line 2 by changing "2005" to -- 2002 -- .

Appropriate correction is required.

***Priority***

6. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 10/266,040, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. Specifically, applicants have now added to claim 31 the limitation that the inboard and outboard tire walls are each "at least about 3½ inches in length", however a review of the original disclosure in the parent application reveals that it only supports a length -- in the range of about 3½ inches to 5½ inches -- .

One way for applicants to regain the benefit of the earlier filing date would be to incorporate new claim 43 (reciting the supported range) into claim 31.

***Oath/Declaration***

7. This application presents a claim for subject matter not originally claimed or embraced in the statement of the invention. See paragraph 6 above. A supplemental oath or declaration is required under 37 CFR 1.67. The new oath or declaration must properly identify the application of which it

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is to form a part, preferably by application number and filing date in the body of the oath or declaration. See MPEP §§ 602.01 and 602.02.

Note that if applicants regain the benefit of the earlier filing date by claiming only subject matter fully supported by the original parent application disclosure a supplemental oath or declaration will no longer be required.

*Claim Rejections - 35 USC § 112*

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 49, 51, and 52 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a new matter rejection.

Applicants now claim that “a majority” of the flange seat is substantially vertical, the outboard tire wall between “the flange seat” and the tread “tapers” inwardly, and “a substantial portion” of the flange seat includes a curved surface, however the original disclosure supports only - the flange seat consists of an upper portion and a lower portion and the upper portion is substantially vertical -- (specification paragraphs 0040 and 0051 and Figures 7 and 11), -- the outboard tire wall between the wheel protector and the tread extends inwardly -- (specification paragraphs 0047-0048 and Figure 11), and -- the flange seat consists of an upper portion and a lower portion and the lower portion includes a curved surface -- (specification paragraphs 0040 and 0051).

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 46 and 47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants now claim the extent of the wheel protector with respect to the extent of a hypothetical outboard face of a wheel mounted within the tire, however the extent of the outboard face of the wheel is not explicitly defined and the wheel itself is not a standard wheel for which the extent of the outboard face would be implicitly defined and therefore one of ordinary skill in the art would not be reasonably apprised of the metes and bounds of these claims.

One way to overcome this rejection would be to claim the combination, such as

46. (currently amended) The tire of Claim 31 in combination with a wheel mounted within the tire, wherein the wheel protector ~~[[is configured to extend]]~~ extends at least about 1/16 inch beyond an outboard face of ~~[[a]]~~ the wheel ~~[[mounted within the tire]]~~.

47. (currently amended) The tire and wheel combination of Claim 46, wherein the wheel protector ~~[[is configured to extend]]~~ extends between about 1/16 inch and about 1/4 inch beyond an outboard face of ~~[[a]]~~ the wheel ~~[[mounted within the tire]]~~.

12. Claims 44, 45, 49, 51, and 52 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 44 and 49 applicants should clarify that “horizontal” and “vertical” are with respect to the tire axial direction. In claim 51 due to the new matter set forth in paragraph 9 above it appears applicants intended to recite -- extends inwardly -- rather than “tapers inwardly”; for purposes of this examination claim 51 will be so interpreted, but correction is required. In claim 52 the term

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“substantial portion” is a relative term which renders the claim indefinite: the term is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

### *Claim Objections*

13. Claims 46 and 47 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. See paragraph 11 above: due to the indefinite nature of these claims as currently drafted they do not further limit the subject matter of claim 31 from which they depend.

### *Claim Rejections - 35 USC § 103*

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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16. Claims 31, 32, 35-42, 46, 47, 49, and 51-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Casanova et al. (4,856,572) in view of McDonald (4,343,342).

The only difference between the claimed tire and the Casanova et al. tire is the newly added requirement for words indicating a recommended tire pressure positioned on a portion of the outboard tire wall radially outward beyond the flange seat. Specifically, see Casanova et al. embodiment of Figure 1: the flange seat of each tire wall extends from the inner tire diameter (axis Z-Z') to the height (width)  $H_e$  (axis X-X') just below the axially outwardly extending protective rib; the height of the tire walls  $H=585$  mm (23 inches); the thickness  $e$  of the protective rib is 11 mm (0.43 inch); and the flange seat height (width)  $H_e$  is clearly depicted as a little less than half of  $H$ , so the flange seat height (width)  $H_e$  is a little less than 292 mm (11.5 inches) which clearly meets the claimed at least about 1-1/2 inches; as to claims 38 and 42, a little less than half meets the claimed "at least about one-half". McDonald teaches to provide the safety warning information required by the US Department of Transportation (which, as one of ordinary skill in the art understands, includes the recommended tire pressure) on the outboard tire wall above the maximum section width point near the tire shoulder in order to maximize legibility of the information and on the inboard tire wall below the maximum section width point near the tire bead in order to allow for retreading without loss of the information (col. 1 line 9 - col. 2 line 39). It would therefore have been obvious to one of ordinary skill in the art to provide the safety warning information required by the US Department of Transportation (which, as one of ordinary skill in the art understands, includes the recommended tire pressure) in the above tire on the outboard tire wall above the maximum section width point (protective rib) near the tire shoulder in order to maximize legibility of the information and on the inboard tire wall below the maximum section width point near the tire bead in order to allow for retreading without loss of the information. As to claims 46 and 47, see



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paragraph 13 above. As to claim 49, the figure clearly shows a majority of the flange seat to be “substantially” vertical (no definition of “substantially” in this context which would exclude the flange seat shown in the figure).

17. Claims 31, 32, 35-42, 46-49, and 51-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki (4,319,618) in view of McDonald (4,343,342).

The only difference between the claimed tire and the Suzuki tire is the newly added requirement for words indicating a recommended tire pressure positioned on a portion of the outboard tire wall radially outward beyond the flange seat. Specifically, see Suzuki embodiment of Figure 1: the flange seat of each tire wall extends from the inner tire diameter (axis a-a) to the height (width) of  $H-D=413\text{ mm} - 180\text{ mm} = 233\text{ mm}$  (9.2 inches); the ledge extends to a width of  $0.5(SW_M - SW) = 0.5(470\text{ mm} - 440\text{ mm}) = 15\text{ mm}$  (0.61 inch); as to claims 36-38 and 40-42, the height (width) of the tire wall is clearly depicted as a little less than  $H=413\text{ mm}$ , so the flange seat height (width) is a little more than  $233\text{ mm}/413\text{ mm} = 56\%$  of the height (width) of the tire wall.

McDonald teaches to provide the safety warning information required by the US Department of Transportation (which, as one of ordinary skill in the art understands, includes the recommended tire pressure) on the outboard tire wall above the maximum section width point near the tire shoulder in order to maximize legibility of the information and on the inboard tire wall below the maximum section width point near the tire bead in order to allow for retreading without loss of the information (col. 1 line 9 - col. 2 line 39). It would therefore have been obvious to one of ordinary skill in the art to provide the safety warning information required by the US Department of Transportation (which, as one of ordinary skill in the art understands, includes the recommended tire pressure) in the above tire on the outboard tire wall above the maximum section width point ( $SW_M$ ) near the tire shoulder in order to maximize legibility of the information and on the inboard

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tire wall below the maximum section width point near the tire bead in order to allow for retreading without loss of the information. As to claims 46 and 47, see paragraph 13 above. As to claim 48, Figure 1 clearly shows the portion of the outboard tire wall immediately adjacent to  $SW_M$  substantially outward of the portion of the flange seat immediately adjacent the ledge. As to claim 49, Figure 1 clearly shows a majority of the flange seat to be “substantially” vertical (no definition of “substantially” in this context which would exclude the flange seat shown in the figure).

18. Claims 31, 32, 35-42, and 46-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Application Publication 2004/0007303 A1 in view of McDonald (4,343,342).

The only difference between the claimed tire and the US '303 tire is the newly added requirement for words indicating a recommended tire pressure positioned on a portion of the outboard tire wall radially outward beyond the flange seat. Specifically, see the embodiment of Figure 1, paragraphs 0011-0022:  $H_2=7.8$  inches and can be as low as approximately 60% of  $H_1$  = approximately 6.3 inches;  $0.5(D_4-D_2)=0.2$  inch;  $H_4$ =approximately 2.0 inches and can vary from approximately 1.7 inches to 3.0 inches; for  $H_2=7.8$  inches the exemplary  $H_4$  is approximately 26% of  $H_2$  and  $H_4$  can vary from approximately 22% to 38% of  $H_2$ ; for  $H_2=6.3$  inches the exemplary  $H_4$  is approximately 32% of  $H_2$  and can vary from approximately 27% to 48% of  $H_2$ . McDonald teaches to provide the safety warning information required by the US Department of Transportation (which, as one of ordinary skill in the art understands, includes the recommended tire pressure) on the outboard tire wall above the maximum section width point near the tire shoulder in order to maximize legibility of the information and on the inboard tire wall below the maximum section width point near the tire bead in order to allow for retreading without loss of the information (col. 1 line 9 - col. 2 line 39). It would therefore have been obvious to one of ordinary skill in the art to provide the safety warning information required by the US Department of Transportation (which, as

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one of ordinary skill in the art understands, includes the recommended tire pressure) in the above tire on the outboard tire wall above the maximum section width point (42) near the tire shoulder in order to maximize legibility of the information and on the inboard tire wall below the maximum section width point near the tire bead in order to allow for retreading without loss of the information. As to claims 46 and 47, see paragraph 13 above. As to claim 48, Figure 1 clearly shows the portion of the outboard tire wall immediately adjacent to 42 substantially outward of the portion of the flange seat immediately adjacent the ledge. As to claim 49, Figure 1 clearly shows a majority of the flange seat to be "substantially" vertical (no definition of "substantially" in this context which would exclude the flange seat shown in the figure).

#### ***Allowable Subject Matter***

19. Claim 43 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

20. Claims 44 and 45 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adrienne C. Johnstone whose telephone number is (571) 272-1218. The examiner can normally be reached on Monday-Friday, 10:30AM-7:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

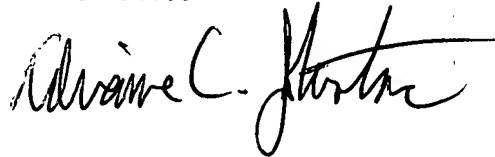
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Adrienne C. Johnstone  
Primary Examiner  
Art Unit 1733

Adrienne Johnstone

April 28, 2007

A handwritten signature in black ink, appearing to read "Adrienne C. Johnstone", written in a cursive style.